

ATTORNEY DOCKET NO. 13215.0023U1
PMCD Docket No. PMCD-31
PATENT

REMARKS

This is a full and timely response to the non-final Office Action (Paper No. 3) mailed by the U.S. Patent and Trademark Office on May 23, 2003. Claims 1-28 remain pending in the present application. Claims 1, 3-19 and 28 are amended. Applicant respectfully submits that support for the amendments can be found in the specification at least on page 7, line 26 through page 9, line 23, and with respect to Figures 2-8. In view of the foregoing amendments and following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 3-4 and 6-28 stand rejected under 35 U.S.C. §112, Second Paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action lists several instances of insufficient antecedent basis. Applicant has amended claims 3-19 and 28 to provide proper antecedent basis.

Rejections Under 35 U.S.C. §103

Claims 1-19, 22 and 24-28

Claims 1-19, 22 and 24-28 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,862,390 to Weiner in view of U.S. Patent No. 5,805,164 to Blum *et al.* To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d

488, 20 USPQ2d 1438 (Fed. Cir. 1991). For a claim to be properly rejected under 35 U.S.C. §103, "[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). Further, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

For at least the reason that the proposed combination fails to disclose, teach, or suggest at least Applicant's method of providing suggested completions for a numeric data entry, comprising: "applying a set of rules to the numeric data entry to identify a candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which a candidate match is selected,*" as recited in claim 1, Applicant respectfully submits that the proposed combination *does not* render Applicant's independent claim 1 obvious.

Similarly, for at least the reason that the proposed combination fails to disclose, teach, or suggest at least Applicant's method of providing suggested completions for a numeric data entry, comprising "applying a set of rules to the numeric data entry to identify at least one candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the at least one candidate match is selected,*" as recited in claim 10, Applicant

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respectfully submits that the proposed combination *does not* render Applicant's independent claim 10 obvious.

Further, for at least the reason that the proposed combination fails to disclose, teach, or suggest at least Applicant's apparatus for providing auto-completions for a partially entered numeric data entry by offering candidate matches, comprising "apply a set of rules to identify a candidate match for said numerical data entry from the list of stored telephone numbers accessed via the stored telephone number memory interface, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected,*" as recited in claim 19, Applicant respectfully submits that the proposed combination *does not* render Applicant's independent claim 19 obvious.

Claim 1

For convenience of analysis, independent claim 1 is repeated below in its entirety.

1. A method of providing suggested completions for a numeric data entry, comprising the steps of:

- a) receiving a numeric data entry;
- b) applying a set of rules to the numeric data entry to identify a candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which a candidate match is selected;* and
- c) receiving a response signal associated with the candidate match.

(Applicants' independent claim 1 - *emphasis added.*)

Applicants respectfully assert that the proposed combination fails to disclose, teach,

or suggest at least the emphasized elements of pending claim 1 as shown above. Consequently, claim 1 is allowable.

Specifically, the proposed combination fails to disclose, teach, or suggest at least Applicant's method of providing suggested completions for a numeric data entry, comprising "applying a set of rules to the numeric data entry to identify a candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which a candidate match is selected.*"

Weiner appears to disclose an apparatus and method for selecting entries within a plurality of entries and includes a search control processor which causes an edit box and a list box to be displayed on a display. The list box displays a subset of entries from a plurality of entries. As letters are typed on a keyboard, the letters are displayed in the edit box. The search control processor causes a first entry from the plurality of entries to be highlighted when the first letter(s) of the first entry match the letters displayed in the edit box and when the first entry is in alphabetical order before any other entry from the plurality of entries whose first letter(s) match the letter(s) displayed in the edit box. *See Weiner, Abstract.*

From this it is clear that *Weiner* relies merely on alphabetical matching of letters entered in an edit box with a subset of entries from a plurality of entries. When a user types a letter in the edit box, the search control processor merely "highlights the entry from entries 33 which is in alphabetical order first among those entries from entries 33 whose first letters match the letters within edit box 31." *See Weiner, col. 4, lines 50-54. Weiner* appears to merely match an entered letter with an entry from a list having a matching alphabetical entry.

Blum et al. appears to disclose a user interface that uses a variable or changeable displayed field label and an associated data entry field for displaying and entering stored database properties. *See Blum et al.*, Abstract.

In marked contrast to the proposed combination, the present invention discloses a method of providing suggested completions for a numeric data entry, comprising at least "applying a set of rules to the numeric data entry to identify a candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which a candidate match is selected.*"

Applicant respectfully submits that the proposed combination fails to disclose, teach or suggest at least Applicant's feature of "applying a set of rules to the numeric data entry to identify a candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which a candidate match is selected.*"

Thus, the proposed combination fails to disclose, teach, or suggest each element of Applicant's independent claim 1. Consequently, Applicant respectfully submits that claim 1 is allowable over the proposed combination and requests that the rejection of claim 1 be withdrawn.

Because independent claim 1 is allowable dependent claims 2-9, which depend either directly or indirectly from allowable independent claim 1 are also allowable. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 1-9 be withdrawn.

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Claim 10

For convenience of analysis, independent claim 10 is repeated below in its entirety.

10. A method of providing suggested completions for a numeric data entry, comprising the steps of:

- a) receiving a numeric data entry;
- b) applying a set of rules to the numeric data entry to identify at least one candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the at least one candidate match is selected*; and
- c) receiving a response signal associated with the at least one candidate match.

----- (Applicants' independent claim 10 - *emphasis added*.) -----

Applicants respectfully assert that the proposed combination fails to disclose, teach, or suggest at least the emphasized elements of pending claim 10 as shown above. Consequently, claim 10 is allowable.

Specifically, the proposed combination fails to disclose, teach, or suggest at least Applicant's method of providing suggested completions for a numeric data entry, comprising "applying a set of rules to the numeric data entry to identify at least one candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the at least one candidate match is selected.*"

As stated above, *Weiner* appears to disclose an apparatus and method for selecting entries within a plurality of entries and includes a search control processor which causes an edit box and a list box to be displayed on a display. The list box displays a subset of entries from a plurality of entries. As letters are typed on a keyboard, the letters are displayed in the edit box. The search control processor causes a first entry from the plurality of entries to be highlighted when the first letter(s) of the first entry match the letters displayed in the edit box and when the first entry is in alphabetical order before any other entry from the plurality of entries whose first letter(s) match the letter(s) displayed in the edit box. *See Weiner, Abstract.*

From this it is clear that *Weiner* relies merely on alphabetical matching of letters entered in an edit box with a subset of entries from a plurality of entries. When a user types a letter in the edit box, the search control processor merely highlights the entry from entries 33 which is in alphabetical order first among those entries from entries 33 whose first letters match the letters within edit box 31." *See Weiner, col. 4, lines 50-54. Weiner* appears to merely match an entered letter with an entry from a list having a matching alphabetical entry.

As stated above, *Blum et al.* appears to disclose a user interface that uses a variable or changeable displayed field label and an associated data entry field for displaying and entering stored database properties. *See Blum et al., Abstract.*

In marked contrast to the proposed combination, the present invention discloses a method of providing suggested completions for a numeric data entry, comprising at least "applying a set of rules to the numeric data entry to identify at least one candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the*

plurality of variables defining a plurality of search states from which the at least one candidate match is selected."

Applicant respectfully submits that the proposed combination fails to disclose, teach or suggest at least Applicant's feature of "applying a set of rules to the numeric data entry to identify at least one candidate match from a list of possible matches, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the at least one candidate match is selected.*"

Thus, the proposed combination fails to disclose, teach, or suggest each element of Applicant's independent claim 10. Consequently, Applicant respectfully submits that claim 10 is allowable over the proposed combination and requests that the rejection of claim 10 be withdrawn.

Because independent claim 10 is allowable dependent claims 11-18, which depend either directly or indirectly from allowable independent claim 10 are also allowable. *See In re Fine, Supra.* Accordingly, Applicants respectfully request that the rejection of claims 10-18 be withdrawn.

Claim 19

For convenience of analysis, independent claim 19 is repeated below in its entirety.

19. An apparatus for providing auto-completions for a partially entered numeric data entry by offering candidate matches, said candidate matches being selected from telephone numbers accessible to the apparatus, the apparatus comprising:

- a) a stored telephone number memory interface for accessing a list of

stored telephone numbers;

- b) a memory device for containing a program module;
- c) an input interface; and
- d) a processing unit coupled to the memory device, the stored telephone number interface and the input interface, the processing unit being operative in response to instructions of the program module to:
 - i) receive a numerical data entry from the input interface; and
 - ii) apply a set of rules to identify a candidate match for said numerical data entry from the list of stored telephone numbers accessed via the stored telephone number memory interface, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*

(Applicants' independent claim 19 - *emphasis added.*)

Applicants respectfully assert that the proposed combination fails to disclose, teach, or suggest at least the emphasized elements of pending claim 19 as shown above. Consequently, claim 19 is allowable.

Specifically, the proposed combination fails to disclose, teach, or suggest at least Applicant's apparatus for providing auto-completions for a partially entered numeric data entry by offering candidate matches, to "apply a set of rules to identify a candidate match for said numerical data entry from the list of stored telephone numbers accessed via the stored telephone number memory interface, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*"

As stated above, *Weiner* appears to disclose an apparatus and method for selecting entries within a plurality of entries and includes a search control processor which causes an edit box and a list box to be displayed on a display. The list box displays a subset of entries from a plurality of entries. As letters are typed on a keyboard, the letters are displayed in the edit box. The search control processor causes a first entry from the plurality of entries to be highlighted when the first letter(s) of the first entry match the letters displayed in the edit box and when the first entry is in alphabetical order before any other entry from the plurality of entries whose first letter(s) match the letter(s) displayed in the edit box. *See Weiner, Abstract.*

From this it is clear that *Weiner* relies merely on alphabetical matching of letters entered in an edit box with a subset of entries from a plurality of entries. When a user types a letter in the edit box, the search control processor merely "highlights the entry from entries 33 which is in alphabetical order first among those entries from entries 33 whose first letters match the letters within edit box 31." *See Weiner, col. 4, lines 50-54. Weiner* appears to merely match an entered letter with an entry from a list having a matching alphabetical entry.

As stated above, *Blum et al.* appears to disclose a user interface that uses a variable or changeable displayed field label and an associated data entry field for displaying and entering stored database properties. *See Blum et al., Abstract.*

In marked contrast to the proposed combination, the present invention discloses an apparatus for providing auto-completions for a partially entered numeric data entry by offering candidate matches, to "apply a set of rules to identify a candidate match for said numerical data entry from the list of stored telephone numbers accessed via the stored

telephone number memory interface, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*"

Applicant respectfully submits that the proposed combination fails to disclose, teach or suggest at least Applicant's program module to "apply a set of rules to identify a candidate match for said numerical data entry from the list of stored telephone numbers accessed via the stored telephone number memory interface, *the set of rules implementing a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*"

Thus, the proposed combination fails to disclose, teach, or suggest each element of Applicant's independent claim 19. Consequently, Applicant respectfully submits that claim 19 is allowable over the proposed combination and requests that the rejection of claim 19 be withdrawn.

Because independent claim 19 is allowable dependent claims 22 and 24-28, which depend either directly or indirectly from allowable independent claim 19 are also allowable. *See In re Fine, Supra.* Accordingly, Applicants respectfully request that the rejection of claims 19, 22 and 24-28 be withdrawn.

No Motivation to Combine *Weiner* and *Blum et al.*

Applicants respectfully submit that there is no motivation to combine *Weiner* with *Blum et al.* to arrive at the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some

teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further, "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re, Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Applicants respectfully submit that there is nothing in *Weiner* or *Blum et al.* that would motivate one having ordinary skill in the art to combine these references to arrive at the dialing completion method and apparatus that incorporates a set of rules, which implement *a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*

~~Further, neither *Weiner* or *Blum et al.* provide either a reasonable expectation of~~
~~success of combining the references to provide *a plurality of variables, the plurality of*~~
~~*variables defining a plurality of search states from which the candidate match is selected.*~~

Specifically, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness because the Office Action has not pointed out the specific teachings in either *Weiner* or *Blum et al.* that would motivate one having ordinary skill in the art to combine the references to arrive at Applicant's invention.

For at least the reasons stated above, the proposed combination of *Weiner* and *Blum et al.* fails to disclose, teach or suggest at least *a plurality of variables, the plurality of variables defining a plurality of search states from which the candidate match is selected.*

Accordingly, Applicants respectfully submit that one having ordinary skill in the art would not, and could not, combine the proposed references, one of which discloses a simple alphabetical recognition system, and the other of which discloses a user interface that uses a variable or changeable displayed field label and an associated data entry field for displaying and entering stored database properties, to arrive at Applicant's invention.

Claims 20, 21 and 23

Claims 20, 21 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,862,390 to Weiner in view of U.S. Patent No. 5,805,164 to Blum *et al.* and further in view of U.S. Patent No. 5,708,804 to Goodwin *et al.*

Applicants respectfully submit that claims 20, 21 and 23 are allowable for at least the reason that they depend directly from allowable independent claim 19. *In re Fine, supra.*

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CONCLUSION

For at least the foregoing reasons, Applicant respectfully requests that all outstanding rejections be withdrawn and that all pending claims of this application be allowed to issue. If the Examiner has any comments regarding Applicant's response or intends to dispose of this matter in a manner other than a notice of allowance, Applicant requests that the Examiner telephone Applicant's undersigned attorney.

Respectfully submitted,

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